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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,212	03/23/2000	Dale F. McIntyre	79910F-P	1233

1333 7590 03/11/2003

PATENT LEGAL STAFF  
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EXAMINER	
POND, ROBERT M	
ART UNIT	PAPER NUMBER

3625

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/533,212	MCINTYRE, DALE F.
	Examiner	Art Unit
	Robert M. Pond	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 17 December 2002 .

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-8,11-13 and 15-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8,11-13 and 15-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 23 March 2000 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant cancelled Claims 9, 10, 14, and 21-22, and amended Claims 1, 3, 4, 8, 11, 12, 15, 18, and 20. All pending claims, 1-8, 11-13, and 15-20 were examined. New art pertinent to solving the problem of preventing waste of unused portions of prepaid product was cited in this non-final office action.

### ***Response to Arguments***

The Applicant did not file any arguments under the heading "Remarks" traversing the 35 USC 103(a) rejections. This examiner is satisfied with the Applicant's corrections entered to remove 35 USC 112 rejections. Applicant's argument regarding amended Claims 8 and 11 being in appropriate form is persuasive.

### ***Drawings***

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Applicant is required to submit corrected drawings of the noted defects. Applicant is required to submit drawing corrections promptly. Drawing corrections may no longer be held in abeyance. Noted defects include: Figures 1-2 do not meet margin requirements and depict hand-drawn references and annotation. Please see 37 CFR 1.84 for drawing standards.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 1 recites the limitation "accrued" in line 3 of claim element "c." There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-8, 12-13, 15-16, and 19-20 are rejected under 35 USC 103(a) as being unpatentable over Shiota et al., patent number 6,324,521, in view of Pagano, patent number 5,692,834, further in view of Amirpanahi, patent number 5,648,906.**

Shiota et al. teach a system and method of Fuji Photo Film Company of providing customers with a photographic service via a computer network. Shiota et al. teach a fulfillment center managing one or more orders, routing photo processing jobs to minilabs and special laboratories, processing and delivering automatically to the customer a first set of prints, and customers connecting remotely to the service via the Internet for viewing, ordering extra prints or other products and services, sharing photos with friends, and billing systems to process customer service charges (see at least abstract; Fig. 1 (1, 2, 3, 4, 5); Fig. 6 (36); Fig. 7 (6); col. 1, lines 54-67; col. 2, lines 1-9; col. 2, lines 56-67; col. 7, lines 58-62). Shiota et al. teach image retaining devices comprising one or more rolls of photographic film, creating a first set of prints and then electronically scanning and converting into digital images for online viewing (see at least Fig. 1 (7); col. 2, lines 33-41), storing digital images in databases (see at least Fig. 6 (33, 34, 38, 40); col. 10, lines 65-67; col. 11, lines 1-12), and automatically providing a product after reaching a predetermined criteria (col. 9, lines 40-52, col. 10, lines 4-29). Registration information for an order comprises a reception number unique to the order, a processing number unique to the service requested for the images being supplied, and a plurality of image numbers or image identification (ID) numbers, each being unique to the associated digital image (see at least Fig. 2; col. 3, lines 31-35). Shiota et al. teach the use of a web browser plug-in to facilitate browsing and image viewing, and processing application software to manipulate images prior to ordering goods or service.

Shiota et al. teach services and goods such as outputting prints, extra prints, picture postcard, and compact disc (CD) (see at least Fig. 6 (11); col. 10, lines 54-58), generating pass codes for online access, and arrangements or images in an album (see at least col. 4, lines 28-42). Shiota et al. further teach ordering information comprising one or more formats (see at least Figs. 2; col. 6, lines 46), of which the format in Fig. 2 discloses a unique reception number that is used as a registration number for an image retaining device, each image retaining device number comprising at least one image identified by an image number. Shiota et al. further teach an hierarchical approach to order information processing (see at least Fig. 3; col. 6, line 47) whereby in Fig. 3 Order Information 1 represents ordering information for the first image retaining device, Order Information 2 represents the ordering information of the second image retaining device, and etc., whereby the print order file comprises a group or subgroups associated with a print order.

Shiota et al. teach all the above as noted under the 103(a) rejection and further teach a) providing customer convenience, b) billing and settlement systems, and c) the “reality that not everything, such as depositing a film or receiving a print, can be carried out on a network” and therefore it being customary to provide the service through a local camera shop or a mini-lab as an agency. Shiota et al., however, do not disclose assigning credit on behalf of a customer for unprintable images of a roll of photographic film. Pagano teaches a common practice of personally delivering exposed photographic film products to

a professional photo-finisher or agent of the photo-finisher. Pagano teaches pre-paid film mailers being introduced by certain film manufacturers to provide customers with a more convenient way to have exposed film processed (see col. 1, lines 19-23). Pagano teaches the mailer being sold together with the film product, and the price paid for the mailer depending upon the number of exposures and type of film contained in the associated film cassette or cartridge (see col. 1, lines 31-34). Pagano further teaches a customer purchasing a mailer entitling him to receive 24 prints, receiving 20 prints back from the photo-finisher, and receiving credit for the four prints paid for but not received via a credit slip that is used toward future purchase of film and photo-finishing services (see col. 1, lines 49-60). Therefore it would have been obvious to one of ordinary skill in the art to modify the system and method of Shiota et al. to send a token of monetary value based on a threshold (e.g. 4 images) as taught by Pagano, in order to compensate the customer for unused pre-paid film and processing.

Shiota et al. and Pagano teach all the above as noted under the 103(a) rejection further teach crediting the customer with a credit token for any pre-paid unprocessed prints that were unprintable or not exposed by the customer, but do not specifically disclose automatically updating credit on behalf of a customer by computer for each of a plurality of image orders. Amirpanahi teaches a networked computerized parking meter system and method of monitoring parking spaces and refunding any remaining calculated parking fee from the same parking charge card to the parking charge card upon request or removal of the

vehicle to minimize waste of parking credit (see at least abstract; col. 1, lines 1-16, lines 45-50; col. 2, line 59-60; col. 6, lines 45-48). Amirpanahi teaches parking charge cards comprising any combination of parking credit account cards, prepaid parking cards, and credit cards, wherein customers purchase prepaid parking cards from authorized locations and vending machines. The vending machine prompts the customer purchasing the prepaid charge card for a new personal identification number, and stores the total amount purchased on the charge card's magnetic strip (see at least col. 6, lines 48-52; col. 10, lines 39-50). Amirpanahi teaches the customer entering the password and the desired amount parking time into the parking meter, the central database computer checking the customer's entered password with the password stored on the card's magnetic strip (see at least col. 11, lines 18-30). Upon reinsertion of the parking charge card into the parking meter's magnetic strip reader the central database computer calculates any unused amount of parking fee and adds it back to the customer's parking charge card (see col. 12, lines 33-46). Amirpanahi further teaches the customer no longer having to drive away knowing that some parking time is still left on the parking meter, without being able to get a refund or return credit added back to the charge card (see col. 12, lines 46-60). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al. and Pagano to automatically assign credit to a customer as taught by Amirpanahi, in order to

solve a pertinent problem of preventing waste of unused portions of prepaid photo film product.

**3. Claims 11 and 17-18 are rejected under 35 USC 103(a) as being unpatentable over Shiota et al., patent number 6,324,521, Pagano, patent number 5,692,834, and Amirpanahi, patent number 5,648,906, as applied to Claims 1 and 16, further in view of Official Notice regarding standard film role sizes, hereafter referred to as “ON1,” further in view of Supermarket News (a collection of articles cited in PTO-892, Paper #3 Item: U; Paper #5 Items: U-V).**

Shiota et al., Pagano, and Amirpanahi teach all the above as noted under the 103(a) rejection and teach a) a customer pre-paying for a film mailer entitling the customer to 24 prints and reaching a threshold value of four unprintable images resulting in a credit token, and b) a customer automatically being credited based on pre-determined criteria of minimum allowable increments of time being converted to a refundable rate. Shiota et al., Pagano, and Amirpanahi, however, do not disclose a threshold value equal to the number of images on a roll of film of a predetermined value. This examiner takes the position that it is old and well known within the photographic industry and to its consumers that standard number of images on a roll of film is typically sold in sizes of 12, 24, and 36 exposures. Furthermore, in the pre-paid mailer example noted above, the number of prints processed in the example could have been between 0-24

whereby the example could have easily cited 0 prints or 12 prints resulting in 24 unprinted images or 12 unprinted images respectively as threshold values.

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose a threshold value equal to a standard size roll of film as taught by ON1, in order to show a threshold value equal to the number of available exposures in a standard roll of film.

Shiota et al., Pagano, Amirpanahi, and ON1 teach all the above as noted under the 103(a) rejection and teach receiving a token of credit for unprocessed prints to be applied toward future film and photo-finishing services, but do not teach a token comprising a roll of film. Supermarket News teaches Kroger's introducing a frequent shopper card for its photo customers, receiving free film process after reaching pre-determined criteria of film processing value (e.g. pay for nine processing orders, the tenth roll is processed for free), and using coupons to pay for club card promotions (see Paper #3 Item: U, page 1).

Supermarket News teaches photo processors offering customers a free roll of film based on pre-determined criteria (e.g. buy two rolls and get the third roll free) (see Paper #5 Item: U, page 2). Supermarket News teaches film processing discounts, tie-in rebate offers on film, free second set of prints, free film with developing, and Fuji tear-off instant coupons on three-packs of film for batteries or photo finishing. Supermarket News further teaches giving customers a coupon with each roll of free film to act as an incentive and reminder for customers to return to the retailer for film processing (see Paper #5 Item: V, pages 1-3).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al., Pagano, Amirpanahi, and ON1 to offer customers free film processing, coupons, or free film as taught by Supermarket News, in order to reward customers who reach established criteria, and thereby create potential sales revenue in the future.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**703-305-7687** (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RMP  
February 25, 2003



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